

held to be allowable, the Applicants respectfully request that the withdrawn claims be considered.

## **II. Office Action Summary**

The following claim rejections were submitted by the Examiner in the outstanding Office Action:

- Claims 1-2, 5-6, and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of U.S. Patent Number 3,084,940 to Cissel and U.S. Patent Number 595,494 to O'Meara;
- Claims 8, 15-18, 20, and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Cissel, O'Meara, and U.S. Patent Number 4,027,885 to Rogers; and
- Claims 1, 2, 5-6, 8, 10, 15-18, 20, 22, 27-29, and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over a combination of Rogers and O'Meara.

## **III. Discussion of Claims 1-2, 5-6, 8, and 10**

Independent claim 1 recites a golf club having a shaft and a head secured to the shaft. The head includes a primary element, a cavity, at least one depression, and an insert element. The primary element is at least partially formed of a first material. The primary element also defines a first surface and an opposite second surface, with the first surface providing an area for engaging a golf ball. The cavity is defined by a portion of the primary element that is of unitary construction. The cavity is positioned between the first surface and the second surface, and at least a portion of the cavity extends in a direction that is substantially parallel to the first surface. The at least one depression is defined by the primary element and extends toward the second surface from the cavity. The insert element is formed of a second material and positioned within the cavity. The insert element includes at least one protrusion extending into the depression, and the second material is different than the first material.

The Office Action rejects independent claim 1 as being obvious over the combination of Cissel and O'Meara and the combination of Rogers and O'Meara.

***The Cissel and O'Meara Rejection***

Cissel discloses a golf club head with a substantially vertical slot that receives a plate. In each embodiment of Cissel, the material forming the slot is different than the material forming the face (i.e., the portion of the golf club that contacts the golf ball). More particularly, a first portion of the head forms the slot, and a second portion of the head (which forms the face) is attached to the first portion.

According to independent claim 1, the primary element defines a first surface and an opposite second surface, with the first surface providing an area for engaging a golf ball. In addition, the primary element defines the cavity. Accordingly, independent claim 1 recites a configuration wherein one element defines the face and the cavity. In contrast with independent claim 1, Cissel discloses a configuration wherein two separate, but joined, elements define the slot and the face. O'Meara

Independent claim 1 also recites that the depression extends toward the second surface from the cavity. Each and every element of the claimed invention must be taught or suggested by the prior art. Even if Cissel is read together with O'Meara, no teaching suggests this specific orientation for the depression.

The rejection states that the application does not set forth why the depression/protrusion arrangement is utilized, and the rejection surmises that the depression/protrusion arrangement may be for attaching elements together. The application at issue discusses the reasons for the claimed arrangement. More particularly, the application states that the insert element may be utilized to redistribute mass in the head, thereby modifying the position of the center of gravity of the head (Application, paragraphs 40-41). The depression/protrusion arrangement recited in independent claim 1 may be utilized, therefore, to modify the position of the center of gravity. If, for example, the depression/protrusion arrangement were located in a lower surface of the head, the center of gravity may be shifted upward. Accordingly, the Application sets forth a potential reason for the depression/protrusion arrangement.

The rejection combines Cissel and O'Meara for purposes of providing a means to secure the slot and the plate, and the rejection notes that the attachment system is a matter of design choice. As noted above, the use of a depression/protrusion arrangement may alter the center of

gravity of a golf club. That is, the attachment system proposed in the rejection may be more than a mere design choice, and may have an effect upon the characteristics of a golf club. While the Applicants have noted an advantage to the depression/protrusion arrangement, this advantage was not recognized in Cissel. Accordingly, there was no motivation to make the combination proposed in the rejection.

*The Rogers and O'Meara Rejection*

Rogers discloses a golf club head with a slot that receives a filler material. According to Rogers, "The method of manufacture is illustrated in FIG. 4 where the head 14 can be seen to be formed of a two piece construction; the body 15 and the faceplate 37" (Rogers, column 3, line 68 to column 4, line 3). The slot that includes the filler material is formed, therefore, from two joined elements.

According to independent claim 1, the cavity is defined by a portion of the primary element that is of unitary construction. Accordingly, the portion of the primary element that forms the cavity is a one-piece element. In contrast with independent claim 1, and as discussed above, the slot of Rogers is formed from two joined elements.

Independent claim 1 also recites that the depression extends toward the second surface from the cavity. Each and every element of the claimed invention must be taught or suggested by the prior art. Even if Rogers is read together with O'Meara, no teaching suggests this specific orientation for the depression.

The rejection states that the application does not set forth why the depression/protrusion arrangement is utilized, and the rejection surmises that the depression/protrusion arrangement may be for attaching elements together. The application at issue discusses the reasons for the claimed arrangement. More particularly, the application states that the insert element may be utilized to redistribute mass in the head, thereby modifying the position of the center of gravity of the head (Application, paragraphs 40-41). The depression/protrusion arrangement recited in independent claim 1 may be utilized, therefore, to modify the position of the center of gravity. If, for example, the depression/protrusion arrangement were located in a lower surface of the

head, the center of gravity may be shifted upward. Accordingly, the Application sets forth a potential reason for the depression/protrusion arrangement.

The rejection combines Rogers and O'Meara for purposes of providing a means to secure the filler material and the cavity, and the rejection notes that the attachment system is a matter of design choice. As noted above, the use of a depression/protrusion arrangement may alter the center of gravity of a golf club. That is, the attachment system proposed in the rejection may be more than a mere design choice, and may have an effect upon the characteristics of a golf club. While the Applicants have noted an advantage to the depression/protrusion arrangement, this advantage was not recognized in Rogers. Accordingly, there was no motivation to make the combination proposed in the rejection.

Based upon the above discussion, the Applicants respectfully submit that independent claim 1 is allowable over the combination of Cissel and O'Meara and the combination of Rogers and O'Meara. In addition, claims 2, 5-6, 8, and 10 should be allowable for at least the same reasons.

#### **IV. Discussion of Claims 15-18, 20, and 22**

Independent claim 15 recites a golf club having a shaft and a head secured to the shaft. The head includes a primary element, a cavity, and an insert element. The primary element is formed of a metal material and defines a face and an opposite rear surface. The cavity is defined by a portion of the primary element that is of unitary construction, and the cavity is positioned between the face and the rear surface. The cavity has a substantially constant thickness and extends in a direction between a heel side and a toe side of the head. In addition, the cavity has at least one depression extending toward the rear surface. The insert element is formed of a polymer material and is positioned within the cavity. A portion of the insert element is located within the at least one depression.

The Office Action rejects independent claim 15 as being obvious over the combination of Cissel, O'Meara, and Rogers and the combination of Rogers and O'Meara. The recitation of independent claim 15 includes concepts that are similar to concepts discussed above for

independent claim 1. More particularly, independent claim 15 recites that (a) the primary element is formed of a metal material and defines a face and an opposite rear surface, (b) the cavity is defined by a portion of the primary element that is of unitary construction, and (c) the depression extends toward the rear surface.

For the same reasons that are discussed above for independent claim 1, the Applicants respectfully submit that independent claim 15 is allowable over the combination of Cissel, O'Meara, and Rogers and the combination of Rogers and O'Meara. In addition, claims 16-18, 20, and 22 should be allowable for at least the same reasons.

#### **V. Discussion of Claims 27-31**

Independent claim 27 recites a method of manufacturing a head for a golf club. The method includes a step of forming a primary element of the head from a first material, the primary element having a face and an opposite rear surface. A cavity is defined within a portion of the primary element that is of unitary construction. The cavity is positioned between the face and the rear surface, and at least a portion of the cavity extends substantially parallel to the face. The cavity also includes at least one depression extending toward the rear surface. In addition, the method includes positioning an insert element within the cavity, the insert element being formed of a second material that is different from the first material.

Independent claim 27 recites that the cavity includes a depression extending toward the rear surface. Each and every element of the claimed invention must be taught or suggested by the prior art. Even if Rogers is read together with O'Meara, no teaching suggests this specific orientation for the depression.

Based upon the above discussion, the Applicants respectfully submit that independent claim 27 is allowable over the combination of Rogers and O'Meara. In addition, claims 28-31 should be allowable for at least the same reasons.